

REMARKS

I. Status Summary

Claims 1-6, 8-13 and 29-30 are pending in the present application and are presently examined. The U.S. Patent and Trademark Office (hereinafter "the Patent Office") has rejected claims 1-6, 8-13 and 29-30.

Claims 1-6, 8-13 and 29-30 are rejected under 35 USC § 101. Claims 1-4 are rejected under 35 USC § 102(b) as allegedly being anticipated by Pietu et al. (*Genome Research*, Vol. 6, pp. 492-503, 2000; hereinafter "Pietu et al."). Claims 1-6 and 29 are rejected under 35 USC § 103(a) as allegedly being unpatentable over Jelinsky et al. (*Mol. Cell Biol.*, Vol. 20, No. 21, pp. 8157-67, November 2000; hereinafter "Jelinsky et al.") in view of U.S. Patent Application Publication No. 2007/0037144 to Wohlgemuth et al. (hereinafter "Wohlgemuth et al."). Claims 8-13 are rejected under 35 USC § 103(a) as allegedly being unpatentable over Jelinsky et al. in view of Wohlgemuth et al. in further view of U.S. Patent No. 5,830,645 to Pinkel et al. (hereinafter "Pinkel et al.").

Claim 29 has been canceled without prejudice. Claims 1 and 8 have been amended. Support for these amendments can be found throughout the claims and specification as filed and, in particular, at page 18, line 10; throughout the Examples; and in original claim 29. Accordingly, no impermissible new matter has been added by this claim amendment.

II. Response to the Rejection under 35 U.S.C. § 101

Claims 1-6, 8-13 and 29-30 are rejected under 35 USC § 101 as allegedly failing to recite a tangible step. While Applicants respectfully disagree with the § 101 rejection, in order to facilitate prosecution of the application, the claims are herein amended. Independent claims 1 and 8 are amended to include hybridizing to a microarray. Support for this amendment can be found throughout the specification as originally filed and particularly at page 18, line 10, and throughout the Examples. No new matter has been added. Accordingly, present claims 1-6, 8-13 and 29-30 are

believed to recite a tangible step, and Applicants thus respectfully request withdrawal of the rejection under 35 U.S.C. § 101.

III. Response to the Rejections Under 35 U.S.C. § 102(b)

Claims 1-4 are rejected under 35 USC § 102(b) as allegedly being anticipated by Pietu et al. The Patent Office contends that Pietu et al. teaches each and every element of the rejected claims. Applicants respectfully traverse the rejections under § 102(b).

Without acquiescing to the contentions of the Patent Office, applicants respectfully submit that claim 1 has been amended to recite "genomic DNA". Support for the amendment can be found in original claim 29. Claim 29 has been canceled. No new matter has been added.

Applicants respectfully submit that Pietu et al. fails to teach or suggest a method of correcting oligo probe hybridization signals comprising genomic DNA. Accordingly, applicants respectfully submit that Pietu et al. fails to anticipate each and every element of claim 1, or claims 2-4 depending therefrom. It is therefore respectfully requested that Pietu et al. as a reference be withdrawn, and hence, that the rejection of claims 1-4 under 35 U.S.C. §102(b) be withdrawn.

IV. Response to the Rejections Under 35 U.S.C. § 103(a)

IV.A. Rejection of Claims 1-6 and 29 Over Jelinsky et al. and Wohlgemuth et al.

Claims 1-6 and 29 are rejected under 35 USC § 103(a) as allegedly being unpatentable over Jelinsky et al. (*Mol. Cell Biol.*, Vol. 20, No. 21, pp. 8157-67, November 2000; hereinafter "Jelinsky et al.") in view of U.S. Patent Application Publication No. 2007/0037144 to Wohlgemuth et al. (hereinafter "Wohlgemuth et al."). Applicants respectfully traverse the rejections under § 103(a).

The Patent Office admits that Jelinsky et al. fails to teach the individual calculation of correction coefficients for individual probes where the average signal of the individual probes is made to equal a constant. However, the Patent Office

contends that Wohlgemuth et al. compensates for this deficiency in Jelinsky et al. Applicants respectfully disagree.

Nowhere does Wohlgemuth et al. calculate a correction coefficient for each oligo probe as recited in independent claim 1. Rather, Wohlgemuth et al., at best, appears to correct probe signal for background noise for purposes of selecting expression data for analysis. See, paragraph [0207] of Wohlgemuth et al. Furthermore, the alleged scaling of the data in paragraph [0212] is not believed to be tantamount to correcting oligo probe hybridization signals, comprising calculating a correction coefficient for each oligo probe, as recited in claim 1. In particular, the scaling referenced in paragraph [0212] is not believed to be based upon individual probe correction coefficients, but rather, the median, the mean, the trimmed mean, or percentile of the entire dataset.

Therefore, applicants respectfully submit that Jelinsky et al. and Wohlgemuth et al., alone or in combination, fail to teach each and every element of claim 1. Given that claims 2-6 depend either directly or indirectly from claim 1, they too are believed to be distinguished from the cited references.

Consequently, it is respectfully submitted that the rejection of claims 1-6 under 35 U.S.C. §103(a) as being obvious over Jelinsky et al. in view of Wohlgemuth et al. has been addressed. It is therefore respectfully requested that the rejection of claims 1-6 under 35 U.S.C. §103(a) be withdrawn.

IV.B. Rejection of Claims 8-13 Over Jelinsky et al., Wohlgemuth et al. and Pinkel et al.

Claims 8-13 are rejected under 35 USC § 103(a) as allegedly being unpatentable over Jelinsky et al. in view of Wohlgemuth et al. in further view of U.S. Patent No. 5,830,645 to Pinkel et al. (hereinafter "Pinkel et al."). Applicants respectfully traverse the rejections under § 103(a).

In response, applicants respectfully refer to the discussion hereinabove regarding the failure of Jelinsky et al. and Wohlgemuth et al. to teach each and every

element of the claim 1. Applicants respectfully submit that Jelinsky et al. and Wohlgemuth et al. fail to teach each and every element of claim 8 for at least the same reasons. Furthermore, applicants respectfully submit that Pinkel et al. fails to compensate for the deficiency in the combined teachings of Jelinsky et al. and Wohlgemuth et al. with respect to claim 8.

Therefore, applicants respectfully submit that Jelinsky et al., Wohlgemuth et al. and Pinkel et al., alone or in combination, fail to teach each and every element of claim 8. Given that claims 9-13 depend either directly or indirectly from claim 8, they too are believed to be distinguished from the cited references.

Consequently, it is respectfully submitted that the rejection of claims 8-13 under 35 U.S.C. §103(a) as being obvious over Jelinsky et al. in view of Wohlgemuth et al. and further in view of Pinkel et al. has been addressed. It is therefore respectfully requested that the rejection of claims 8-13 under 35 U.S.C. §103(a) be withdrawn.

CONCLUSION

In light of the above amendments, remarks and the enclosed 131 affidavit, it is respectfully submitted that the present application is now in proper condition for allowance, and an early notice to such effect is earnestly solicited.

If any small matter should remain outstanding after the Patent Examiner has had an opportunity to review the above Remarks, the Patent Examiner is respectfully requested to telephone the undersigned patent attorney in order to resolve these matters and avoid the issuance of another Official Action.

Application Serial No.: 10/500,587

DEPOSIT ACCOUNT

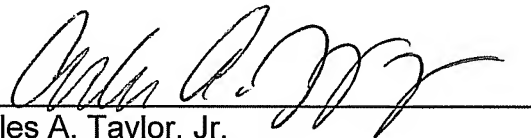
The Commissioner is hereby authorized to charge any additional fees associated with the filing of this correspondence to Deposit Account No. 50-0426.

Respectfully submitted,

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